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MAY 01 2008

OFFICE OF PETITIONS

In re Application of :
LABERGE, STEPHEN P. :
Application Number: 10/604138 : ON PETITION
Filing Date: June 27, 2003 :
Title: SUBSTANCES THAT ENHANCE :
RECALL AND LUCIDITY DURING :
DREAMING

This is a decision in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed January 28, 2008.

On June 27, 2003, petitioner filed the above-identified nonprovisional application, accompanied by the filing fee of \$375.00. The application included two independent claims in excess of three, which required the submission of an additional claims fee in the amount of \$84.00 ($\$42 \times 2 = \84). However, petitioner did not submit the independent claims in excess of three fee on filing the application.

On November 3, 2004, the Office mailed a Notice of Informality Regarding Payment of Fee, setting a period of one month to remit the claims fee in the amount of \$84.00. In response, on December 6, 2004, petitioner submitted a check for the requisite excess claims fee in the amount of \$84.00.

On February 27, 2007, the Office mailed a Notice of Abandonment, indicating that the application had become abandoned for failure to file a timely and proper reply to the Notice of Informality Regarding Payment of Fee of November 3, 2004.

On January 28, 2008, petitioner filed the present petition and a copy of the cancelled check for \$84.00. Petitioner asserted that the Office mailed the Notice of Abandonment in error because the amount

required by the Notice of Informality Regarding Payment of Fee was timely paid. Specifically, petitioners averred:

[] The reason given for the notice of abandonment, "failure to reply in a timely manner to an Office communication" of 11/03/2004, is patently incorrect. The applicant has attached as exhibits B a copy of the canceled/cashed check sent in timely reply to the 11/03/2004 Office communication, and according to examiner Williams, the USPTO electronic records reflect both the timely receipt of a response to the Office communication, and the failure of the USPTO financial office to send any further notice to the agent of any problem or any need for further funds.

Petition of 01/28/08, p. 1.

The Office has considered petitioner's arguments, but does not find them persuasive. Unfortunately, the Notice of Abandonment incorrectly stated that no reply was received in response to the written notification of insufficient funds for the required claims fee. In fact, the Office received a check in the amount of \$84.00 for the independent claims in excess of three fee on December 6, 2007. However, effective November 22, 2004, USPTO fees were revised, and the fees for independent claims in excess of three increased to \$44.00 per claim (i.e. \$88.00). Any amount paid on or after November 22, 2004, was required to be paid as shown in the revised fee schedule. The public was apprised of the change in the fee amount, and the new fee schedule was available on the USPTO website. The Office reminds petitioner that the amount of a fee due is determined by the patent fees in effect on the date on which the fee is received in the USPTO. Therefore, petitioner was required to pay the independent claims in excess of three fee due on December 6, 2004, in the total amount of \$88.00. Accordingly, petitioner's payment on December 6, 2004, was insufficient in the amount of \$4.00.

While the Office attempts to notify an applicant of any fee deficiency in a manner permitting a timely correction, the Office is under no obligation to do such. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction). An applicant is ultimately responsible for ensuring that fees are paid in the proper amount. See 37 CFR 1.6 and MPEP 607. Moreover, it is an applicant's responsibility to take reasonable precautions by apprising himself of the correct fee amounts before payment to the USPTO.

The showing of record is that petitioner failed to timely submit the proper fee amount. Accordingly, the application was properly held abandoned.

The petition to withdraw the holding of abandonment is dismissed. Any request for reconsideration must be submitted within two (2) months of the date of this decision. This time period may not be extended. See 37 CFR 1.181(f).

The Office notes that effective September 30, 2007, the independent claims in excess of three fee has increased to \$105.00 per claim for a total of \$210.00. Thus, petitioner must submit the difference between the current independent claims in excess of three fee less \$84.00, for a total of \$126.00. The Office reminds petitioner to apprise himself of any changes in the fee as the amount due is determined by the date of payment in the USPTO.

Petitioner may wish to consider filing a petition under 37 CFR 1.137(b). The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant § 1.137(d).

The appropriate form is enclosed for petitioner's convenience.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

First named inventor:

Application No.:

Art Unit:

Filed:

Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450
 FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

Other than small entity – fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

- A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):

has been filed previously on _____
 is enclosed herewith.

- B. The issue fee and publication fee (if applicable) of \$ _____

has been paid previously on _____
 is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Signature

Date

Typed or printed name

Registration Number, if applicable

Address

Telephone Number

Address

Enclosures: Fee Payment

Reply

Terminal Disclaimer Form

Additional sheets containing statements establishing unintentional delay

Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Date

Signature

Typed or printed name of person signing certificate

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.